

Amendment After Final 37 C.F.R. 1.116
Applicant: DuWayne C. Radke et al.
Serial No.: 09/904,124
Filed: July 12, 2001
Docket No.: M120.199.101 (56908US002)
Title: PASS-THROUGH FIRESTOP DEVICE

REMARKS

This is responsive to the Final Office Action mailed September 22, 2004. In that Office Action, claims 1, 2-4, 10, and 18 were rejected under the judicially-created Doctrine of Obviousness-Type Double Patenting over Radke et al., U.S. Patent No. 6,694,684 ("Radke"). Claims 1-4, 10, 15, 16, 18, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Münzenberger et al., U.S. Patent No. 6,161,873 ("Münzenberger") in view of Rodriguez et al., U.S. Patent No. 5,588,267 ("Rodriguez"). The Examiner's indication that claims 5, 11-14, 17, and 20 recite allowable subject matter is noted with appreciation. It is further noted that claims 6 and 7 depend from claim 5. While the Office Action Summary indicates that claims 6 and 7 were rejected, the detailed Action provides no such rejection. Thus, it is assumed that claims 6 and 7 are simply objected to by the Examiner. With this Response, claim 20 has been amended to correct an unintentional grammatical error for reasons unrelated to patentability, and a Terminal Disclaimer relating to U.S. Patent No. 6,694,684 is provided. It is respectfully submitted that each of claims 1-7 and 10-20 are allowable for at least the following reasons.

Obviousness-Type Double Patenting Rejections

In response to the rejections of claims 1-4, 10, and 18 under the judicially-created Doctrine of Obviousness-Type Double Patenting, an appropriate Terminal Disclaimer relating to U.S. Patent No. 6,694,684 is submitted. It is respectfully submitted that in light of the Terminal Disclaimer, all double-patenting rejections are traversed.

35 U.S.C. §103 Rejections

A. Non-Analogous Art Criteria Have Never Been Addressed, Let Alone Satisfied.

The Examiner has repeated previous rejections of various claims as being unpatentable over Münzenberger in view of Rodriguez. In each of Applicant's three previous Responses to this rejection, it has been argued that Rodriguez is non-analogous art, and thus is not an available

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reference. In each subsequent response from the Examiner, including the current Final Office Action, the Examiner has never specifically satisfied required criteria relating to the determination of whether Rodriguez is analogous art. Pointedly, while the Examiner has recited the requisite standard that in order to be analogous (and thus available as a basis for rejection), the reference must either (1) be in the field of Applicant's endeavor, or if not, (2) then be reasonably pertinent to the particular problem with which the inventor was concerned, the Examiner has never addressed either factor. For example, in the current Final Office Action, at page 6, the Examiner recites the analogous art determination criteria, but does not state, let alone support, whether Rodriguez is within the field of the Applicant's endeavor, nor whether Rodriguez is reasonably pertinent to the particular problem with which the Applicant was concerned. Instead, the Examiner argues that:

"The fact that the applicant states that it is not within the applicant's field of endeavor, namely firestopping, if the prior art structure is capable of performing the intended use (which would be removing a band – in reference to a frangible section, or a grasping means – in reference to a pull tab, then it meets the claim.

This statement has no relation to the test for determining whether Rodriguez is analogous art. It does not matter whether Rodriguez "meets the claim". Instead, the question is whether Rodriguez is of the same field of endeavor or, if not, then reasonably pertinent to the particular problem with which the Applicant was concerned. In the June 7, 2004 Response, this identical issue was brought to the Examiner's attention along with a specific request that the analogous art factors be addressed. It is respectfully submitted that in light of the Examiner's failure to properly address the analogous art criteria, that the finality of the current Office Action be withdrawn.

A proper review of the analogous art determination criteria dictates that Rodriguez is non-analogous art. To this end, Applicant's previous arguments are incorporated herein by reference. Summarily stated, under factor (1) the Applicant's field of endeavor is a firestop device; as admitted by the Examiner, Rodriguez relates to roof flashing. Thus, Rodriguez is clearly not in the field of the Applicant's endeavor, such that criteria (1) is not satisfied. In addition, under criteria (2), the particular problem with which the present invention was

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concerned is creating a firestop opening in a partition and adjusting the height of the firestop device to match the thickness of the partition. In other words, the length of the firestop device is to be adjusted to match a thickness of the partition surrounding an exterior of the firestop device. In contrast, Rodriguez seeks to address the problem of altering an effective inner diameter of a roof flashing device within which a pipe is disposed. The particular problem addressed by the present invention is unrelated to inner diameter, and the problem addressed by Rodriguez is unrelated to height or length. One of ordinary skill in the art seeking to solve a problem of adjusting a height or length of a firestop device would not reasonably be expected or motivated to look to a roof flashing having an adjustable inner diameter. Because neither of the analogous prior art determination criteria have been satisfied, it is respectfully re-asserted that Rodriguez is not analogous art, and thus cannot be relied upon as a basis for the rejections of independent claims 1 or 18, or any claim depending therefrom.

B. A viable, requisite suggestion to combine Münzenberger has never been identified.

In addition, it is respectfully re-asserted that the Examiner has yet to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires the Examiner to establish a suggestion or motivation to modify a reference or to combine reference teachings. *MPEP* §2143. To this end, the "level of skill in the art" cannot be relied upon to provide the requisite suggestion to combine. *MPEP* §2143.01. Further, the mere fact that references could be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *MPEP* §2143.01. In the current Final Office Action, the Examiner states that it would have been obvious to provide the frangible connection of the housing and the pull tab to grasp the band of Rodriguez with the housing of the firestop device of Münzenberger "in order to provide different lengths of the housing for different sized walls (column 1, lines 35-37)". This alleged "motivation" does not exist in Münzenberger. The language referenced by the Examiner (column 1, lines 35-37) relates to the fact that in different countries, the effective outer diameter of firestop fixtures may differ. This has absolutely nothing to do with providing a firestop housing with different lengths. It is noted that in the

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previous Non-Final Office Action, mailed March 9, 2004, the Examiner recited an alleged "motivation" that "by using the housing of Rodriguez, firestop material could be placed within the housing along the pipe (P) in order to slow down rate of fire from passing from one part of the housing to the next". Because this statement was not repeated in the current Final Office Action, it is assumed that the Examiner has agreed that it is inapplicable. Other than these two statements, the Examiner has never articulated any other alleged motivation. Thus, in the absence of any suggestion or motivation to modify Münzenberger in view of Rodriguez, it is respectfully submitted that a *prima facie* case of obviousness has not been made, and thus that the rejections under 35 U.S.C. §103 be withdrawn.

C. Alleged teachings of the prior art are inconsistently interpreted and do not render the claimed inventions obvious.

In addition, it is respectfully noted that the Examiner has not consistently articulated what teachings of Rodriguez are supposedly being combined into Münzenberger. In particular, the Examiner has initially interpreted the ribs 8 of Münzenberger as being the claimed band(s). If so, in order for the rib/band 8 of Münzenberger to "removable" in accordance with claim 1, the internal annular groove 20 of Rodriguez would have to be formed below the top-most rib/band 8 (relative to the orientation of FIGS. 1 and 2 of Münzenberger). There is simply no motivation for providing an annular groove at this location, as to do so would, upon removing the top-most rib/band 8 and thus all portions of the pipe 7 above this band 8, render the firestop device unfit for its intended purpose in that it would be much too short.

Conversely, the Examiner is perhaps asserting that the combination of Münzenberger in view of Rodriguez would position the conically-shaped top portion (having a tapering inner diameter) of the Rodriguez roof flashing (e.g., that portion of the roof flashing "above" the upper edge seal 12 in FIG. 2 of Rodriguez) on top of the pipe 7 of Münzenberger. If so, there is no support for such a modification. Were a tapered inner diameter top portion applied to the top of the Münzenberger pipe 7, it would impeded the ability to pass cable(s)/pipe(s) through the firestop pipe 7, thus rendering Münzenberger unfit for its intended purpose. Further, the pipe 7 of Münzenberger and the top portion of Rodriguez are made of dissimilar materials, making it

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highly expensive, if not impossible, to mount the top portion of Rodriguez on to the pipe 7 of Münzenberger.

Alternatively, it may be that the Examiner views the modification as consisting of forming the internal annular groove 20 of Rodriguez somewhere along the length of the pipe 7 of Münzenberger apart from the circumferential ribs 8; or in other words, that the Examiner is not viewing the ribs 8 as being the "band" of claim 1. This is entirely inconsistent with the Examiner's assertion that the ribs 8 of Münzenberger are the claimed band(s). Further, a requisite motivation and expectation of success has not been shown for this purported combination. In particular, the collar member 4 of Rodriguez in which the groove 20 is formed is described as being flexible and pliable such that the collar member 4 can be stretched and distended upwardly. (Rodriguez, column 3, lines 15-20). In contrast, the pipe 7 of Münzenberger is a rigid plastic capable of maintaining its integrity when subjected to a cast-in-concrete application. One of ordinary skill would not view a technique for facilitating severing of a stretchable elastomeric material as having any usefulness with a rigid plastic. Also, Münzenberger teaches simple cutting of the pipe 7 (col. 4, lines 13-15); adding an internal groove would not make cutting any easier as a user could not readily correlate a location of an internal groove with an external cut, and would render manufacture of the resultant device more expensive.

In light of the above, it is respectfully submitted that a *prima facie* case of obviousness has not been made. As such, independent claims 1 and 18, as well as all claims depending therefrom, are allowable.

D. Other claim limitations have not been addressed.

In addition, it is noted that claim 2 recites that the removable band includes a pull tab. The Examiner has referenced the annular bead 25 of Rodriguez as satisfying this "pull tab" limitation. Applicant respectfully disagrees. The annular bead 25 of Rodriguez is not part of the "removable band" identified by the Examiner. In particular, the annular groove 20 is formed "above" the bead 25, such that when the upper portion of the collar member 4 is removed at the annular groove 20, the bead 25 remains in place. This fact is clearly evidenced by comparison of

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FIGS. 2 and 4 of Rodriguez, with FIG. 2 representing the collar member 4 prior to removal of the upper section, and FIG. 4 representing the collar member 4 following removal. In both illustrations, the annular bead 25 remains. Thus, the bead 25 of Rodriguez is not part of a "removable band", such that claim 2 recites additionally allowable subject matter.

With respect to claim 16, the Examiner has not identified any reference as teaching the limitation of "said retaining ring is coded to indicate the quantity of firestop material provided in the device". Thus, the rejection of claim 16 is not understood, and it is respectfully submitted that claim 16 recites additionally allowable subject matter.

With respect to independent claim 18, the above arguments relating to the non-analogous nature of Rodriguez as well as the failure to establish a *prima facie* case of obviousness are re-asserted. In addition, claim 18 recites, in part, "a plurality of longitudinally arranged frangibly connected circumferential bands". The Examiner has cited no teachings in Münzenberger or Rodriguez that would otherwise satisfy a plurality of frangibly connected circumferential bands. At best, Rodriguez suggests a single removable collar portion. Even further, none of the cited references teach or suggest the plurality of frangibly connected bands having equal axial lengths. If the Examiner is interpreting the ribs 8 of Münzenberger as being the "bands of equal axial lengths" of claim 18, this interpretation requires that that the ribs/bands 8 of Münzenberger be removable from a remainder of the pipe 7 in order to satisfy the limitations of claim 18; as previously described, there is no motivation or suggestion for this modification. In fact, such a modification would render Münzenberger unfit for its intended purpose. For at least these additional reasons, then, it is respectfully submitted that claim 18 recites allowable subject matter.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-7 and 10-20 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-7 and 10-20 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to the U.S. Patent and Trademark Office, Attn: Examiner Green, of Group Art Unit 3635, and Fax No. (703) 872-9306 on this 22nd day of November, 2004.

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